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| 08/650,709      | 05/20/96    | ALBIN                | D 7693-002-0        |

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OBLON SPIVAK MCCLELLAND  
MAIER AND NEUSTADT  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON VA 22202

EXAMINER

DEXTER, C

ART UNIT

3724

PAPER NUMBER

18

DATE MAILED: 10/01/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/650,709

Applicant(s)  
Albin et al.

Examiner  
Clark F. Dexter

Group Art Unit  
3724



☒ Responsive to communication(s) filed on Sep 23, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 2, 12, 13, and 16-25 is/are pending in the application.

Of the above, claim(s) 2, 12, and 13 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 16-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Sep 23, 1998 is ☐ approved ☒ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on September 23, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/650,709 is acceptable and a CPA has been established. An action on the CPA follows.

### *Drawings*

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 23, 1998 have been **approved**.

3. The drawings stand objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "depressions" as set forth in claim 11 must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered. ↵

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*Claim Objections*

4. Claims 16-24 are objected to because of the following informalities:

Claim 16<sup>x</sup> depends from cancelled claim 14. To expedite prosecution, claim 16 has been examined as depending from independent claim 24.

In claim 24, line 8, "variablewidth" as one word is improper.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

5. Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language.

In claim 24, line 7, "the nip has a variable width" is vague and indefinite since no structure has been set forth to perform this function - i.e., the function of varying the width of the nip; further, it is not clear how the width can be both variable and approximate the height of the cutting elements.

In claim 16, lines 1-2, the phrase "has a circumferential rate" is vague and indefinite since no structure has been set forth to rotate either of the rollers, and thus the longitudinal cutting element; also in lines 1-2, the phrase "has a circumferential rate which is higher than the conveying rate of the polymer gel" is vague and indefinite since the invention is being defined in terms of a

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conveying structure or in terms of the workpiece, neither of which is part of the claimed invention.

In claim 18, line 2, the phrase "is planed or has the form of a sickle" is vague and indefinite since it is recited in the alternative and the alternative forms are not equivalents; further "is planed" is vague as to what structure is being set forth (is it intended to mean planar?).

In claim 19, lines 2-3, the phrase "the cutting roll or the cross-cutting roll" is vague and indefinite as to what is being set forth since there are only two rolls being claimed - a cutting roll (with a cross-cutting element) and a backup roll- and the claimed relationship is not clear.

In claim 20, line 1, "conveys" renders the limitation vague and indefinite since no structure has been set forth to rotate the back-up roll and thus to convey the gel; in lines 2-3, the phrase includes the use of "or" and "or both" which makes it an alternative phrase that renders it vague and indefinite, particularly as to which cutting elements are involved.

In claim 23, lines 2-3, the phrase includes the use of "or" and "or both" which makes it an alternative phrase that renders it vague and indefinite, particularly as to which blade or blades are received by the depressions.

In claim 25, line 1, "constructed to process" is vague and indefinite as to how the device is constructed, and thus as to what structure is being set forth.

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 16, 18-20, 24 and 25, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Heywood.

Heywood discloses a device, particularly in Figures 1-4, with every structural limitation of the claimed invention as best understood from the claims including a cutting roll (F or G-G') with axially extending cross-cutting elements (e.g., "e") and radially extending longitudinal cutting elements (e.g., "c" or "d" or "I"), and a back-up roll (C) which is approximately parallel to the cutting roll; wherein the nip approximates the height of the cross-cutting element, and wherein the cross section of the axially extending cross-cutting element is planed (as best understood) and is parallel to the longitudinal axis of the cutting roll. It is noted that the limitation directed to the width of the nip being variable has been given little patentable weight since no structure has been set forth for this function, and Heywood discloses all of the claimed structure. It is further noted that the slots (a) of Heywood provide this function.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 17, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Heywood.

Heywood discloses flat cross cutters but lacks a disclosure that the cross cutters are formed of flat steel polished on one side. However, the Examiner takes Official notice that it is old and well known in the art to provide cutting blades made of polished steel to keep the blades free of contaminants and to provide a blade having a cleaner appearance. Therefore, it would have been obvious to one having ordinary skill in the art to make the blades, including the cross cutters, of Heywood of polished steel for the well known reasons including those described above.

10. Claims 21-23, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Heywood in view of Stream.

Heywood lacks the back-up roll being coated with plastic and further lacks depressions in the surface of the back-up roll. However, Heywood discloses that the back-up roll is covered with a soft material, specifically "rawhide or any other suitable material". Further, it is old and well known in the art to provide plastic on an anvil or back-up roll as evidenced by Stream to

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enable the blade to press through the workpiece with sufficient pressure to cut the workpiece while not dulling the cutting edge of the blade. Plastic coating is clearly a modern alternative to a rawhide coating, and the specific types of plastic set forth are common forms of plastic. Further, the plastic coating of Stream forms depressions to receive the cutting edges of the blades of the cutter roller and Stream teaches that this establishes a strong traction between the cutter roll and the back-up roll and further prevents wear of the backup roll. Therefore, it would have been obvious to one having ordinary skill in the art to replace the rawhide coating with plastic, particularly the notched coating of Stream, to gain the well known advantages of plastic including increased durability and reduced manufacturing costs as well as the advantages taught by Stream. Further, one having ordinary skill in the art would clearly select a common form of plastic for the well known benefits including availability.

### ***Response to Arguments***

11. Applicant's arguments filed September 23, 1998 have been fully considered but they are not persuasive.

In the second paragraph on page 4 of the amendment, applicant states that the prior art is used for a different purpose than the present invention. However, this is not persuasive because it is well settled that an intended use of a device cannot serve to distinguish an invention over the prior art. Structural differences must be present.



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In the third paragraph on page 4 of the amendment, applicant appears to argue contrary points. First, he argues that the width of the nip approximates the height of at least one of the cutters. Second, he argues that the width of the nip is adjustable so that it may be made larger than the height of one of the cutters. Clearly, if the width of the nip is larger than said height, it cannot meet the claimed limitation that the width of the nip approximates the height of at least one of the cutters. In any event and as previously argued by the Examiner, Heywood clearly discloses the relationship wherein the width of the nip approximates the height of at least one of the axially extending cross-cutting element or radially extending cutting element or both. As shown in Figure 2, for example, the radially extending blade contacts the back-up roller and thus the nip between the rollers is clearly approximately equal to the height of at least the radially extending blade.

Further regarding the variable width nip, there is no structure positively set forth in the claims for adjusting the roll gap. Further, Heywood's device includes slot (a) which allows the spacing between the rolls, and thus the roll gap width, to be adjustable.

In the paragraph bridging pages 4 and 5 of the amendment, applicant argues that the back-up roll and cutting roll are independent from each other, and that this is not the case with Heywood. However, such a relationship is not claimed. Further, with respect to the claims, none of the claims include structure to rotate the longitudinal cutter or structure to convey the gel. Therefore, there is no structure set forth in the claims to perform the recited function. Thus,

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Heywood anticipates the claimed invention because it discloses all of the claimed structure of the present invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[rinaldi.rada@uspto.gov](mailto:rinaldi.rada@uspto.gov)].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
September 30, 1998